RECORD AND BRIEFS

No. 15-1293

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHAIO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

AMICUS BRIEF OF LAW PROFESSORS GREGORY DOLIN, TARA J. HELFMAN, IRINA D. MANTA AND KRISTEN JACOBSEN OSENGA IN SUPPORT OF RESPONDENT

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INTEREST OF *AMICI CURIAE*[1]

Amici curiae Professor Gregory Dolin (University of Baltimore School of Law), Professor Tara J. Helfman (Syracuse University College of Law), Professor Irina D. Manta (Maurice A. Deane School of Law at Hofstra University), and Professor Kristen Jacobsen Osenga (University of Richmond School of Law) are scholars and teachers of intellectual property law and constitutional law.

Amici have no direct stake in the outcome of the present litigation. *Amici* submit this brief in support of the reasoning and decision of the Court of Appeals for the Federal Circuit. *Amici* also highlight likely detrimental consequences on the U.S. intellectual property system as a whole if the Government's and certain *amici*'s arguments concerning § 2(a) of the Lanham Act are accepted.

SUMMARY OF THE ARGUMENT

The United States Constitution protects the citizenry's ability to speak even in a crude, derogatory, and demeaning manner without being penalized by the Government. The Constitution does not permit the Government to suppress or disadvantage offensive commercial speech any more than it does offensive non–commercial speech.

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[1] Petitioner has filed its consent to the filing of amicus curiae briefs in support of either party or of neither party on November 14, 2016. Respondent filed its blanket consent September 30, 2016. Amici and their counsel represent that no party to this case nor their counsel authored this brief in whole or in part, and that no person other than amici paid for or made a monetary contribution toward the preparation and submission of this brief.

Section 2(a) of the Lanham Act violates and cannot co–exist with these simple principles.

The trademark system is designed to allow a merchant to secure the goodwill of his business by identifying his wares. But trademarks also allow merchants and consumers to construct their identities based on the goods bought and sold, markets targeted, and logos displayed. The non–disparagement provisions of § 2(a) significantly limit the ability of merchants and consumers to engage in this expressive conduct.

Reversal of the decision below would effectively transform the United States Patent and Trademark Office from an agency whose purpose is to "promote the Progress of Science and useful Arts," U.S. Const., Art. I, § 8, cl. 8, into a panel of moral censors tasked with purging putatively "offensive" speech from the marketplace of ideas. This represents constitutionally impermissible overreach by the political branches into the spheres of political and economic liberty. Section 2(a) of the Lanham Act unconstitutionally confers upon the PTO the power to suppress speech that it deems offensive by denying it trademark protection. Not only does this contravene established First Amendment doctrine, but it also compromises the very foundations of intellectual property law. The Government may not prohibit speech, be it commercial or non–commercial, on the ground that some listeners may find it offensive. Doing so would create a heckler's veto on property rights by leaving trademark applicants without any means under the law to protect their exclusive legal interest in their own ideas. Adopting Petitioner's argument will have a destructive ripple

effect into all areas of intellectual property law and adverse consequences on long established and valuable property rights.

ARGUMENT

I. Any Ban On The Registration Of Offensive Marks Is Impermissible Viewpoint Discrimination

The provisions of § 2(a) of the Lanham Act, 15 U.S.C. 1052(a), unconstitutionally discriminate against speech based on the viewpoint of the speaker. On its face, § 2(a) discriminates against certain speech not only because of the topic discussed, but because of the messaged conveyed. At bottom, the statute permits the Government to accord benefits to speech on a variety of controversial topics such as race, gender, sexuality, and the like based on whether the speaker expresses a popular and "acceptable" viewpoint on the topic, or unpopular and disfavored viewpoints. Trademark registration is not denied to applicants who seek to identify their goods with particular race, gender, or ethnicity, but is denied if such an identification raises the ire of some portion of the populace. Thus, marks such as such as *Yid Dish*,[2] *Dykes on Bikes*,[3] *The Guidos of*

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[2] Registration No. 4131892 (registered April 24, 2012) (for "newsletters featuring news and feature articles concerning dating, relationships").

[3] Registration No. 3323803 (registered Oct. 30, 2007) (for "[e]ducation and [e]ntertainment [s]ervices in the nature of organizing, conducting, and promoting . . . parties and rallies to support, organize and motivate women motorcyclists . . . .").

Comedy,[4] and *Mulata*[5] have been registered and enjoy the benefits of such registration, while SLANTS and REDSKINS (among other marks), *see* Pet. App. 23a, have been denied registration and its benefits.

A. Third–Party Participation is Irrelevant for the Purposes of the Analysis

Under the statute, the Patent and Trademark Office ("PTO") will deny registration to a mark if the mark is disparaging. In analyzing whether this prohibition is triggered, the PTO determines whether the proposed mark "refer[s] to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group." PTO, *Trademark Manual of Examining Procedure* (*"TMEP"*) § 1203.03(b)(i) (Oct. 2016), https://mpep.uspto.gov/RDMS/TMEP/current. This reliance on third–party views of the mark is seen as a matter of constitutional significance by the Government and by some *amici*. *See* Brief of Law Professors at 9–12 (hereinafter "Tushnet Brief").

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[4] Registration No. 4508998 (registered April 8, 2014) (for "[e]ntertainment services in the nature of comedy shows").

[5] Registration No. 5048032 (registered Sept. 27, 2016) (for "[e]ntertainment services in the nature of comedy shows"). The registration explains that the "English translation of 'Mulata' in the mark is 'Mulatto Woman.'" *Id.* "Mulatto," especially given its etymology (from Spanish and Portuguese for "mule") is often considered pejorative. *See* Judy Scales-Trent, *On Being Like a Mule, in The Social Construction of Race and Identity in the United States* 287 (Joan Ferrante & Prince Brown, Jr. eds., 1998).

Under either First Amendment or Trademark law, however, the distinction between the Government's disapproval of speech and the Government's enforcement of a third party's disapproval of speech is irrelevant.

1. First Amendment law does not differentiate between the Government's suppression of speech and the Government's enforcement of the heckler's veto

This Court has held, time and again, that the First Amendment does not permit the Government to ban speech because a listener might find it offensive. *See Bible Believers v. Wayne County, Mich.*, 805 F.3d 228, 248 (6th Cir. 2015) (en banc), *cert. denied*, 136 S. Ct. 2013 (2016) ("A review of Supreme Court precedent firmly establishes that the First Amendment does not countenance a heckler's veto."). "'If there is a bedrock principle underlying the First Amendment, it is that the Government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.'" *United States v. Eichman*, 496 U.S. 310, 319 (1990) (quoting *Texas v. Johnson*, 491 U.S. 397, 414 (1989)).

This Court has been clear that the Government is not permitted to privilege the feelings or viewpoints of one group over the viewpoints of another group. *See Forsyth County, Ga. v. Nationalist Movement*, 505 U.S. 123, 134 (1992). "[I]t is firmly settled that under our Constitution the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to

some of their hearers, or simply because bystanders object . . . ." *Bachellar v. Maryland*, 397 U.S. 564, 567 (1970). That the Government itself may have no objection to the speech is not relevant. What is relevant is whether the Government uses its considerable power to suppress speech because some portion of the populace finds that particular expression offensive. Simply put, "offensiveness was 'classically not [a] justificatio[n] validating the suppression of expression protected by the First Amendment. At least where obscenity is not involved, . . . the fact that protected speech may be offensive to some does not justify its suppression.'" *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 72 (1983) (quoting *Carey v. Population Services International*, 431 U.S. 678, 701 (1977)). On this issue, the Court has never differentiated between commercial and non–commercial speech. *Id.*

Contrary to the assertion of some *amici*, the fact that the mark's perception may change with the times—and thus its offensiveness or lack thereof is not static—makes the prohibitions contained within § 2(a) more, not less, constitutionally suspect. The ever–shifting perception of offensiveness and the ever–changing cohort of people who may find something offensive can serve as a perfect cover to government officials intent on ridding the market of words, phrases, or images of which it disapproves. *See Fla. Bar v. Went For It, Inc.*, 515 U.S. 618, 639 (1995) ("[T]he State is doing nothing more . . . than manipulating the public's opinion by suppressing speech . . . ."); *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 641 (1994) ("Laws of this sort pose the inherent risk that the Government seeks not to

advance a legitimate regulatory goal, but to suppress unpopular ideas or information or manipulate the public debate through coercion rather than persuasion. These restrictions 'rais[e] the specter that the Government may effectively drive certain ideas or viewpoints from the marketplace.'" (quoting *Simon & Schuster, Inc. v. Members of State Crime Victims Bd.*, 502 U.S. 105, 116 (1991))). The decision to refuse to register or cancel a registered mark that, in the Government's opinion, is or has become "disparaging" will always be shaped by the prevailing political winds rather than by some "'neutral' assessment of a non–government perspective–in this case, a 'substantial composite of the referenced group,'" Pet. App. 99a (Dyk, J., concurring and dissenting), even if such "neutral assessment" were possible. The ultimate decision whether to cancel a trademark's registration rests with the Director of the Patent and Trademark Office. 15 U.S.C. § 1068. The Director, of course, is a political appointee, appointed by and serving at the pleasure of the President. 35 U.S.C. § 3. One need not be a conspiracy theorist to surmise that the Director might be more likely to uphold disparagement claims that are made by groups with which a given Administration is trying to curry favor. In the final analysis, then, the decision to refuse to register or cancel a mark is entirely political and based on what type of speech the Government wishes to suppress at present.

The Government's power to regulate speech depending on prevailing political winds illustrates why § 2(a) is, contrary to the claims of some of the *amici*, inapposite to restrictions on defamatory

speech. *See* Tushnet Br. 8–12. Defamatory speech remains defamatory irrespective of time or place, because the *sine qua non* of defamation is the falsity of the statement. *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 370 (1974) (White, J. dissenting) ("Under typical state defamation law, the defamed private citizen had to prove only a false publication that would subject him to hatred, contempt, or ridicule."); *Old Dominion Branch No. 496, Nat. Ass'n of Letter Carriers, AFL–CIO v. Austin*, 418 U.S. 264, 283 (1974) ("The *sine qua non* of recovery for defamation . . . is the existence of falsehood. . . . [T]here must be a false statement of fact."). The truth or falsity of a fact, of course does not vary depending on prevailing societal attitudes. A falsehood uttered or printed today will not become true with passage of time; nor will a true statement lose its veracity when read by subsequent generations. And while it is possible that false statements may have different reputational effects depending on prevailing societal norms, the evolution of societal views only affects the compensation due to the victim of false statements. It is the falsity of the statement rather that the evolution of societal views that serves as a constitutional basis for prohibiting such speech in the first place. *See Gertz*, 418 U.S. at 340 ("[T]here is no constitutional value in false statements of fact. Neither the intentional lie nor the careless error materially advances society's interest in uninhibited, robust, and wide–open debate on public issues. They belong to that category of utterances which are no essential part of any exposition of ideas, and are of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and

morality.") (internal citations and quotations omitted)).

2. Because of the nature of a trademark, the Government must always evaluate the public's reaction, but the ultimate decision rests with the Government

A trademark by its very nature is a device meant to impart information to the public regarding the source of goods. "The purpose for which the trademark law accords merchants the exclusive right to the use of a name or symbol in their area or commerce is *identification*, so that . . . the consuming public can rely on a mark as a guarantee that the goods or services so marked come from the merchant who has been found to be satisfactory in the past." *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 147 (2d Cir. 2003) (emphasis in original). Necessarily then, in order to evaluate any application for registering a mark, the PTO has to view the application from the perspective of the consuming public. *See* TMEP § 1202.04 ("The critical inquiry in determining whether a slogan or term functions as a trademark or service mark is how the proposed mark would be perceived by the relevant public."); *Roux Labs., Inc. v. Clairol, Inc.*, 427 F.2d 823, 825 (C.C.P.A. 1970) ("A principal way of determining whether a particular expression is 'merely descriptive' [and therefore not registerable as a trademark] as applied to the goods is to ascertain the reaction of those to whom it is directed—the consumers."). It is therefore unsurprising that the Government looks at a trademark application through the eyes of a third party; doing anything else is simply impossible if the

identification purposes of the Lanham Act are to be preserved.

While the Government has to assume the perspective of private parties in order to determine "whether a slogan or term functions as a trademark," TMEP § 1202.04, the Government is not thereby transformed into a private party unbound by First Amendment constraints. When the Government assumes the power to enforce private viewpoints, its ability to act is circumscribed by the Constitution. *Cf. Shelley v. Kraemer*, 334 U.S. 1 (1948). The government cannot discriminate against trademarks it finds "disparaging" by claiming to be a mere ventriloquist for private parties.

B. The First Amendment Equally Prohibits Outright Suppression of Speech and Disqualification for Government Favors

It is true that denial of trademark registration does not in and of itself ban the applicant from using his chosen device to mark his goods. However, "[s]peech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend a hostile mob." *Forsyth County*, 505 U.S. at 134–35. Without question, denial of trademark registration places financial burdens on the holder of the mark. Trademark registration is not a mere cataloguing of the trademarks currently in existence. An owner of a registered trademark possesses a much more valuable commodity than an owner of an unregistered one.

Registering a mark provides a number of benefits to the registrant. Such benefits include: 1) serving

as a constructive nationwide notice of ownership, 15 U.S.C. § 1072; 2) providing *prima facie* evidence of validity and a right to exclusive nationwide use of the mark, *id.* § 1057(b); 3) guaranteeing federal court jurisdiction for trademark infringement without an amount in controversy or diversity requirement, *id.* § 1121; 4) making the mark eligible for treble damages and attorney's fees in an infringement suit, *id.* § 1117; 5) securing incontestability of the mark after five years of registration, *id.* § 1065; and 6) empowering the owner to prevent importation of counterfeit goods bearing the mark into the United States, *id.* § 1124.

By contrast, the owner of an unregistered trademark has much higher barriers to enforcing his mark. First, in any litigation he bears the burden of proof that he has acquired and continues to hold valid trademark rights. In satisfying the burden, an owner of unregistered trademark cannot simply point to the fact of registration, but must show "dates of first use of the mark, and perhaps the manner and frequency of use of the mark; which persons or entities use the mark (if the mark is used by licensees or other related entities); inherent or acquired distinctiveness of the mark; and other facts relevant to validity and ownership." Lee Ann W. Lockridge, *Abolishing State Trademark Registrations*, 29 Cardozo Arts & Ent. L.J. 597, 601 (2011). Second, the owner of such a mark must prove the geographic reach of his rights, which may not be national in scope. *See id.*; *Restatement (Third) of Unfair Competition* § 19 (1995). The owner may not be eligible to present his proof in federal court, because an owner of an unregistered

trademark would be subject to the diversity and the amount in controversy requirements. *Kaplan v. Helenhart Novelty Corp.*, 182 F.2d 311, 312 (2d Cir. 1950). Even if the owner of an unregistered trademark could invoke the jurisdiction of federal courts and prove ownership, geographic reach, and infringement, he still would not be able to avail himself of the same remedies that an owner of the registered mark would. For example, an owner of a registered mark is able to collect treble damages from an adjudged infringer, whereas an owner of an unregistered mark is only able to do so if he proves that the infringement was willful. *See* 15 U.S.C. § 1117(a). Nor can the owner of an unregistered trademark easily exclude counterfeit goods from the United States. While the statute does grant the U.S. Customs and Border Protection authority to exclude goods infringing both registered and unregistered marks, *see id.* § 1124, Customs limits its enforcement only to registered marks, *see* 19 C.F.R. § 133.1(a) (extending eligibility for enforcement only to "[t]rademarks registered by the U.S. Patent and Trademark Office").

More fundamentally, it is not even certain that an applicant to whom federal registration was denied on the grounds of "disparagement" can maintain any common law rights in his unregistered mark. "It is conceivable that a court, applying broad equitable principles, might refuse to protect a trademark that it believes is scandalous, immoral, or disparaging by holding that such marks are inherently unprotectible [*sic*] because their use contravenes public policy." Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of*

Scandalous and Immoral Trademarks, 83 Trademark Rep. 661, 676 (1993). As the Federal Circuit pointed out, "[t]he government has not pointed to a single case where the common law holder of a disparaging mark was able to enforce that mark, nor could we find one. The government's suggestion that [the applicant] has common law rights to his mark appears illusionary." Pet. App. 38a–39a. In fact, the unavailability of common law protection to marks denied registration under the disparagement provision seems to be the consensus view. *See Restatement (Third) of Unfair Competition* § 32 (1995) ("If a designation used as a trademark . . . is deceptive, or if its use is otherwise in violation of public policy . . . the owner may be barred in whole or in part from the relief that would otherwise be available . . . ."); *Model State Trademark Act* § 1(c) (2007) ("The term 'mark' as used herein includes any trademark or service mark, entitled to registration under this Act whether registered or not.") Indeed, *amici* signatories to the Tushnet Brief recognize as much. *See* Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Rep. 797, 862–64 (2016).

In short, denial of registration, while not an outright prohibition on speech, is a sufficient disincentive that is likely to cause the trademark owner to forego speech that meets with Government's opprobrium. The only way a trademark holder can avoid losing the ability to protect his property and goodwill is by "chang[ing his] message . . . or refrain[ing] from speaking altogether . . . ." *Arizona Free Enter. Club's Freedom Club PAC v. Bennett*, 564 U.S. 721, 739 (2011).

However, "forcing that choice– . . . change your message, or do not speak–certainly contravenes 'the fundamental rule of protection under the First Amendment, that a speaker has the autonomy to choose the content of his own message.'" *Id.* (quoting *Hurley v. Irish–American Gay, Lesbian and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 573 (1995)). In essence, the principle "that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable," *Johnson*, 491 U.S. at 414, "applies not only to affirmative suppression of speech, but also to disqualification for government favors," and therefore "Congress is generally not permitted to pivot discrimination against otherwise protected speech on the offensiveness or unacceptability of the views it expresses," *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 601 (1998) (Souter, J., dissenting).

II. Invalidating § 2(a) Does Not Call Into Question Other Requirements Of The Lanham Act

In support of the Petitioner's position, the Tushnet Brief contends that affirming the judgment below would call into question the entirety of Lanham Act, because all requirements for trademark registration are content–based restrictions. These concerns are overwrought and should not preclude this Court's affirmance.

A. No Other Sections of the Lanham Act Discriminate on the Basis of Viewpoint

The Lanham Act imposes several limitations on the applicant's ability to register his trademark.

Specifically, in addition to the "disparagement" bar, the Act denies registration to marks that comprise of 1) "immoral, deceptive, or scandalous matter," 15 U.S.C. § 1052(a); 2) geographical indications inconsistent with the WTO Agreement, *id.*; 3) flags, coat of arms, and other symbols of a political entity, *id.* § 1052(b); 4) "name, portrait, or signature identifying a particular living individual except by his written consent," *id.* § 1052(c); as well as marks that are either 5) sufficiently similar as to be confusing to a previously used mark, *id.* § 1052(d); or 6) are merely descriptive, *id.* § 1052(e). None of these restrictions save for ones on "disparaging," "immoral" or "scandalous" matters are problematic from the First Amendment point of view.

Unlike the prohibitions on "disparaging," "immoral" or "scandalous" matter which target the applicant's viewpoint, *see* Part I, *ante*, the remaining restrictions are viewpoint neutral. A trademark applicant will be denied registration for a mark containing the American flag irrespective of whether that flag is proudly fluttering in the wind or is micturated upon. Similarly, an application for a merely descriptive mark will be refused irrespective of whether the description is laudatory or derogatory.

Furthermore, these restrictions, unlike the prohibitions on "disparaging," "immoral," or "scandalous" matter serve the very purpose of trademark law. The purpose of trademark law is to allow a merchant to identify for the public the source of goods and to capture the goodwill that accrues to him as a result of his efforts. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) ("The Lanham Act provides national protection of

trademarks in order to secure to the owner of the mark the goodwill of his business . . . ."). Allowing someone to use a flag or similar symbol, or to improperly describe geographical origin of goods, or to affix someone else's name or portrait to the goods would result in the merchant capturing not his own goodwill, but the goodwill of the jurisdiction whose flag is used, or of the person whose likeness graces the mark, or of the region misidentified on the label. In other words, these symbols would not serve as trademarks because they would not identify for consumers the true source of the goods. *See Kathreiner's Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kneipp Med. Co.*, 82 F. 321, 325 (7th Cir. 1897) (holding that where "the name, the portrait, and the facsimile signature of [another are] employed," it can be concluded that the merchant is appropriating "the good will of a trade which belonged to another," and the public is deceived "into the belief that [the] goods were . . . prepared with the knowledge and under the sanction" of the pictured individual); *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 628–29 (S.D.N.Y. 1985) (explaining that evocation of another's persona may cause the public to believe that the referenced person "is somehow involved in or approves of their product").

Similarly, "[m]arks which are merely descriptive of a product . . . do not inherently identify a particular source, and hence cannot be protected." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992). A merely descriptive mark simply does not work as a mark "because it does not inherently identify a particular source of the product." *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll.*

v. Smack Apparel Co., 550 F.3d 465, 475 (5th Cir. 2008). However, if "in the minds of the public, the primary significance of [an otherwise descriptive mark] is to identify the source of the product rather than the product itself," *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211 (2000) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851, n.11 (1982)), it may be able to serve the proper function of a trademark and be eligible for registration, *see* 15 U.S.C. § 1052(f).

In contrast, a "disparaging" mark can serve as an identifier of the source of goods. By choosing the name "The Slants," Respondent does not seek to capture the goodwill (or for that matter ill-will) towards a particular geographic region, another musician, or someone else's goods. Similarly, by choosing the name Redskins, the Washington football club is not leading consumers to believe that the product comes from anywhere other than the football club. In fact, in suggesting that Mr. Tam would retain common law rights to his trademark under § 43(a) (whatever the merits of that argument may be, *see* Part I.B, *ante*), Petitioner recognizes the "disparaging" marks work as a mark. Thus, the prohibitions on "disparaging," "immoral" or "scandalous" serve an entirely different function and have an entirely different result than other prohibitions in § 2.

Fundamentally, prohibitions on "disparaging," "immoral" or "scandalous" matter are different in kind than the other exclusions contained in § 2 of the Lanham Act, and therefore the Court need not be concerned that affirming the judgement below will undermine the trademark regime.

B. Other § 2 Exclusions Survive Intermediate Scrutiny

Even if this Court were to view other exclusions of § 2 with the same skepticism as the prohibitions on "disparaging," "immoral" or "scandalous" matter, only the former but not the latter would survive intermediate scrutiny applicable to the restrictions on commercial speech. *See Fla. Bar*, 515 U.S. at 623.

Under the intermediate scrutiny standard, "government laws and regulations may significantly restrict speech, as long as they also 'directly advance' a 'substantial' government interest that could not 'be served as well by a more limited restriction.'" *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 583 (2011) (quoting *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564 (1980)). When the Government "regulates commercial messages to protect consumers from misleading, deceptive, or aggressive sales practices, or requires the disclosure of beneficial consumer information, the purpose of its regulation is consistent with the reasons for according constitutional protection to commercial speech," *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 501 (1996), and the regulation survives intermediate scrutiny. *Sorrell*, 564 U.S. at 583. As discussed in Part II.A, *ante*, the prohibitions on the use of flags, portraits of living individuals, improper geographic designations, and marks likely to cause confusion in the eyes of the consuming public exist precisely in order to "protect consumers from misleading [and] deceptive . . . sales practices." *44 Liquormart*, 517 U.S. at 501. Similarly, the requirement that goods not be geographically misidentified is simply a "disclosure of beneficial

consumer information," *id.*, which allows a consumer to know that a bottle of Cognac comes from France, while Vidalia onions are from the state of Georgia, and Darjeeling tea is from India.

The prohibition on registering a merely descriptive mark also satisfies intermediate scrutiny. A merely descriptive mark is "not indicative of particular goods or services, but of their nature." *Gen. Adjustment Bureau, Inc. v. Gen. Ins. Adjustment Co.*, 258 F. Supp. 535, 538 (N.D. Okla. 1966), *aff'd*, 381 F.2d 991 (10th Cir. 1967). "To permit exclusive appropriation of such terms would be to permit monopolization of a common term and would constitute an infringement upon common speech." *Id.* Absent the ability of everyone to use common descriptive terms to describe their wares, "fair and open competition might be impaired, the available vocabulary of descriptive words would be reduced, advertisers could not freely describe their products, and the public might be deprived of information necessary to make purchase decisions." *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 565 n.27 (1987) (internal quotations omitted).

The restrictions on registering merely descriptive words can therefore be justified on two grounds. First, by maintaining that exclusion, the public is provided with "beneficial consumer information" which is "necessary to make purchase decisions" — an entirely permissible way to regulate commercial speech. *See 44 Liquormart*, 517 U.S. at 501; *cf. Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 757 (1976) (holding that there is a First Amendment "right to receive . . .

advertising."). Second, by denying monopoly rights to common words, the Government safeguards the remaining public against "substantial infringement upon common speech." *Homemakers Home & Health Care Servs., Inc. v. Chicago Home for Friendless*, 484 F.2d 625, 628 (7th Cir. 1973). Preservation of a multiplicity of voices in the market place is an important government interest under the intermediate scrutiny analysis applicable to commercial speech. *See, e.g., Turner Broad. Sys.*, 520 U.S. at 213; *Satellite Broad. & Commc'ns Ass'n v. FCC*, 275 F.3d 337, 364–65 (4th Cir. 2001).

In contrast, restrictions on "disparaging," "immoral," or "scandalous" matter cannot be justified on any constitutional grounds. Three potential justifications are advanced by the Petitioner and the Tushnet Brief: 1) reducing "the likelihood that 'underrepresented groups in our society' will be 'bombarded with demeaning messages in commercial advertising,'" Pet. Br. 48; 2) disassociation from hateful messages, Pet. Br. 37–41; and 3) protecting the ability of others to speak more freely, Tushnet Br. 13–15. None of these justifications are consistent with this Court's jurisprudence.

Reduction in "the likelihood that 'underrepresented groups in our society' will be 'bombarded with demeaning messages in commercial advertising'" while laudable, cannot be achieved by restrictions on commercial speech. This Court explicitly held that "a State may not prohibit only that commercial advertising that depicts [certain groups] in a demeaning fashion." *R.A.V. v. City of St. Paul, Minn.*, 505 U.S. 377, 389 (1992). "[I]t is firmly settled that under our Constitution the public

expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers, or simply because bystanders object to peaceful and orderly demonstrations." *Bachellar*, 397 U.S. at 567.

Nor is this protection even necessary as the free market is able to police the truly disparaging marks and force the owners to change. For example, an iconic Philadelphia cheesesteak shop chose to change its name from Chink's Steaks to Joe's Steaks + Soda Shop after it was "chastised by Asian Americans in a series of Philadelphia Daily News articles, and in 2008, [seeing] the Philadelphia Bar Association t[ake] the unusual step of issuing a resolution critical of the name." Michael Klein, *Chink's Steaks Changing Its Name*, Philly.com (Mar. 28, 2013), http://www.philly.com/philly/food/Chinks-Steaks-changing-its-name.html. FAGS candy cigarettes changed its name to FADS because the former terms (though still used as a slang for "cigarette butts" in a number of Commonwealth countries) became associated with a pejorative term for gay men. https://en.wikipedia.org/wiki/FADS_Fun_Sticks.

Other examples abound. The NCAA, a private entity, banned (with some exceptions) name and mascots associated with Native Americans. Press Release, Nat'l Collegiate Athletic Ass'n, *NCAA Executive Committee Issues Guidelines for Use of Native American Mascots at Championship Events* (Aug. 5, 2005). In 1962, concomitant with their move to California the then Philadelphia Warriors abandoned their logo which consisted of a caricature of a Native American. Mark Tracy, *The Most Offensive Team Names in Sports: A Definitive*

Ranking, Slate.com (Oct. 9, 2013). In 1971, as a result of public pressure, Fritos abandoned the use of Frito Bandito. https://en.wikipedia.org/wiki/Frito_Bandito. In 1955, in a state not then–known for its liberal views on race, the Aughinbaugh Canning Co. of Mississippi renamed its "Nigger Head Brand" oysters to "Negro Head Brand" after repeated pressure from the NAACP. *Offensive Racial Images Used for Marketing*, The Root, Feb. 20, 2014, http://www.theroot.com/articles/culture/2014/02/seriously_racist_products/. If the public perceives The Slants to be an offensive term, Mr. Tam will bear the consequences of lower tickets sales and fewer performances booked.[6]

Petitioner's analogy to *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), is inapt. True, the Government can, consistent with the First Amendment, decline to give its imprimatur to speech that it finds problematic. *See id.* Thus, the Government can decline to exhibit certain monuments in a public park, *Pleasant Grove City v. Summum*, 555 U.S. 460 (2009), or refuse to issue license plates with a design of which it doesn't approve, *Walker*, 135 S. Ct. 2239. The reason Government can do so is that in those cases it is itself a speaker, *id.* at 2251, or is perceived as such by a reasonable observer, *Summum*, 555 U.S. at 471.

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[6] Indeed, some scholars have argued that silencing hate speech actually undermines equal respect because it denies minorities that spark for protest so essential to the right of conscience. David A. J. Richards, *Free Speech and the Politics of Identity* 126–50 (1999).

In registering a trademark, the Government neither engages in "expressive conduct," nor can be reasonably perceived to do so. Issuing a trademark registration to a disparaging mark is no different than registering a deed to real property belonging to a hate group. An applicant for trademark registration is akin not to the Respondent in *Walker*, but to an individual who wishes to apply for a state-issued license plate for a car bearing a confederate plate bumper sticker. Taken to its logical conclusion, the Petitioner's argument would allow a state to deny license plates to such applicants because the plates would enable these individuals to display the Confederate flag, *e.g.*, the General Lee, on public roads. Petitioner's argument would also mean that the Government could refuse to provide an Employer Identification Number or refuse to issue various licenses to engage in business activities to corporations having "disparaging" names, because such numbers and licenses, much like trademarks, also appear on government registers. This cannot be the law.

Finally, the argument advanced in the Tushnet brief also provides no justification for § 2(a) strictures. The Tushnet Brief argues that by denying registration to disparaging marks, the Government actually promotes rather than restricts speech. Denial of registration, the argument goes, denies the applicant the ability to suppress speech of others. Tushnet Br. 13–15. This argument is truly puzzling. An exclusive right to a trademark in one party does not actually preclude anyone from speaking. When used in commerce, a trademark "is a form of commercial speech and nothing more."

Friedman v. Rogers, 440 U.S. 1, 11 (1979). "Requiring [other] commercial speaker[s] to choose words and labels that do not confuse or deceive protects the public and does not impair expression," *Silverman v. CBS Inc.*, 870 F.2d 40, 48 (2d Cir. 1989), and therefore does not suppress anyone's speech. To the extent other members of the public wish to use the trademarked word or symbol for non–commercial purposes such as parody, criticism, comparison to own goods, non–deceptive description of own services, and the like, the First Amendment and the Lanham Act protect their right to do so. *See New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (holding that the doctrine of fair use protects speakers who use the mark of another "to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose."). "When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth. It is not taboo." *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924). The only reduction in speech that trademark registration contemplates is the reduction in deceptive and misleading commercial speech, *i.e.*, speech that has "no First Amendment value." *U.S. Healthcare, Inc. v. Blue Cross of Greater Philadelphia*, 898 F.2d 914, 928 n.15 (3d Cir. 1990).

Anyone who wishes to use the term Slants as a racial slur, to describe (or criticize) the band, and even to sell own products so long as the use is not misleading is free to do so irrespective of whether the term is or is not a registered trademark, and at least one of the signatories to the Tushnet Brief recognizes

as much. *See* William McGeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 Notre Dame L. Rev. 253, 288–91 (2013) (noting that "[m]ost courts" to consider third party uses of trademarks in their own expressive conduct "have adopted some variety of a so–called 'First Amendment defense.'"). On the other hand, denying the registration to a disfavored term makes it nearly impossible for the applicant to use that term to describe his own goods irrespective of how much the public associates the term with his goods and how much goodwill he has acquired.

III. Holding For The Petitioner Will Threaten The Rest Of The Intellectual Property Regime

Trademarks are not the only intellectual property rights that could be threatened if the Government prevails in this case. Copyrights, utility patents, and design patents could all be denied to the creators of works the Government deems "disparaging."

A. All the Arguments Against Trademark Registration Apply to Copyright Registration

As is the case with trademarks, a creative work need not be registered with the Copyright Office in order to receive copyright protection. *See Brownstein v. Lindsay*, 742 F.3d 55, 67 (3d Cir. 2014) ("[C]opyright registration does not establish the copyright, which attaches at the moment of creation."). Needless to say, an untold number of copyrighted works use racial, sexist, homophobic, and other degrading epithets in order to convey their message. These epithets can be found anywhere

from popular music, to hit Hollywood shows such as *The Sopranos*, to classic American novels such as *To Kill a Mockingbird*. All of these works have engendered controversy, protests, and criticism for their crude depiction of "underrepresented groups in our society." Under the Government's approach, it could deny copyright registration to the authors of these works because registration "would cause the work to be published on the [Copyright Catalog]; would cause a certificate for the [work] to be issued "in the name of the United States (which may be transmitted to foreign countries)," Pet. Br. 39, and would allow the registrant access to other governmental benefits such as the ability to stop importation of infringing works. 17 U.S.C. §§ 502–505, 602. If access to these benefits in the context of trademarks is sufficient to "associate" the Government with the speech of the mark's owners, it is equally sufficient to "associate" it with the much more extensive (and often more vulgar) speech of the copyright applicant.

The Tushnet Brief argues that a copyright cannot be analogized to a trademark because, in the words of the signatories, "to mandate that a work of authorship be non–disparaging or non–obscene to get protection would be to target the content of the work itself as a condition of the benefits of protection," while trademark law "protects only the source identification function of a symbol and not the symbol itself." Tushnet Br. 30. This is an odd distinction because in trademark, as elsewhere, "words are often chosen as much for their emotive as their cognitive force." *Cohen v. California*, 403 U.S. 15, 26 (1971).

> Customers value some products as much for what they symbolize as for what they do. For brands like Coke, Budweiser, Nike, and Jack Daniel's, customers value the brand's stories largely for their identity value. Acting as vessels of self–expression, the brands are imbued with stories that consumers find valuable in constructing their identities.

Douglas B. Holt, *How Brands Become Icons: The Principles of Cultural Branding* 3 (2004). *See also Au–Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1067 (9th Cir. 2006) ("Consumers sometimes buy products bearing marks such as the Nike Swoosh, the Playboy bunny ears, the Mercedes tri–point star, the Ferrari stallion, and countless sports franchise logos, for the appeal of the mark itself, without regard to whether it signifies the origin or sponsorship of the product.").

The use of "Slants" allows both the producer and consumer to construct their identities—that of an Asian band (and their devotees) both of whom hold particular set of political views. Thus, the Tushnet Brief's suggestion that Mr. Tam can protect his commercial interest if he were to "choose[] some other symbol to make the link between itself and its goods and services," Tushnet Br. 30, just would not do. It is akin to suggesting that the cult classic *The*

Big Lebowski could receive copyright registration only for the edited–for–TV version where the famous phrase "This is what happens when you fuck a stranger in the ass" is replaced by the anodyne, albeit nonsensical, phrase "This is what happens when you find a stranger in the Alps."

All of the arguments the Tushnet Brief raises with respect to trademarks are applicable to copyright as well. If it is true that the denial of trademark registration does not prevent anyone from speaking and allows the mark owner to continue to use the mark, just without the additional benefits of registration, then it is equally true that a denial of copyright registration also does not preclude anyone from speaking and allows the author to continue publishing his work, just without the benefit of federal copyright registration. If it is true that denial of trademark registration increases speech by denying the mark owner the ability to suppress the speech of others, then it is equally true that the denial of copyright registration will increase speech because it will deny the author the ability to suppress the speech of others. Both trademarks and copyrighted works have a significant expressive component to them, and their treatment cannot but rise and fall together.

B. Patents Will Also Be Threatened

The Patent Act offers protection to inventors of new and useful products and designers who create new and original ornamental designs. 35 U.S.C. §§ 101, 171. "[D]esign patents explicitly cover expressive content in the form of an ornamental design applied to a product or the ornamental shape

of a product." Andrew Beckerman–Rodau, *Design Patent Evolution: From Obscurity to Center Stage*, 32 Santa Clara High Tech. L.J. 53, 90 (2016). "To qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989). Of course, what's "aesthetically pleasing" to some is revolting to others, or as Latin maxim teaches, *de gustibus non est disputandum.* And yet, the PTO refuses applications "which could be deemed offensive to any race, religion, sex, ethnic group, or nationality, such as those which include caricatures or depictions" as "as nonstatutory subject matter." PTO, *Manual of Patent Examining Procedure* ("MPEP") § 1504.01(e) (Nov. 2015), https://www.uspto.gov/web/offices/pac/mpep/ (citing 35 U.S.C. § 171).[7] Though the restrictions on design patents are not part of the present case, they are *in pari materia*, for in both the trademark and design patent context the PTO takes upon itself the function of an arbiter of what is offensive and to whom. "Under our Constitution, 'esthetic and moral judgments about art and literature . . . are for the individual to make, not for the Government to decree, even with the mandate or approval of a majority.'" *Brown v. Ent. Merchants Ass'n*, 564 U.S. 786, 790 (2011) (quoting

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[7] Unlike the Lanham Act, the Patent Act itself does not exclude offensive subject matter, and the exclusion is a result of the PTO rule only. *Compare* 35 U.S.C. § 171 (allowing anyone who "invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor"), *with* MPEP § 1504.01(e).

United States v. Playboy Entertainment Group, Inc., 529 U.S. 803, 818 (2000)).

Because "the clear purpose of the design patent law is to promote progress in the 'art' of industrial design," *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981), it follows that denying such patents would advantage and advance some ideas that the Government prefers and disadvantage and stifle those it opposes, even if the proponents of those ideas would technically remain able to promote them. Reversing the judgment below would allow the PTO to retain the authority to discriminate not only in the field of trademarks, but also in the field of design patents, which in turn would endow the government with the power to favor only those viewpoints that it itself finds "aesthetically pleasing," and will deprive the citizenry of their "right to receive information and ideas, regardless of their social worth," which "is fundamental to our free society." *Stanley v. Georgia*, 394 U.S. 557, 564 (1969).

But design patents would not alone be threatened by reversing the judgment below. Utility patents, and with them "the Progress of Science and useful Arts," U.S. Const., Art. I, § 8, cl. 8, would also be in peril. Although utility patents are not often thought of as having a First Amendment "expressive" function, *see, e.g.*, Ralph D. Clifford & Richard J. Peltz–Steele, *The Constitutionality of Design Patents*, 14 Chi.-Kent J. Intell. Prop. 553, 598 (2015), certain inventions can be viewed as immoral by either the Government or the members of the general public, *see* Ann Bartow, *Pornography, Coercion, and Copyright Law 2.0*, 10 Vand. J. Entm't & Tech. L. 799, 830 (2008). Prior to the modern First

Amendment doctrine, "courts invalidated patents . . . on the ground that they were immoral." *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1367 (Fed. Cir. 1999) (citing *Brewer v. Lichtenstein*, 278 F. 512 (7th Cir. 1922), *Schultze v. Holtz*, 82 F. 448 (N.D. Cal. 1897), and *Nat'l Automatic Device Co. v. Lloyd*, 40 F. 89 (N.D. Ill. 1889)). Thankfully, the practice has been abandoned decades ago. *See Ex Parte Murphy*, 200 U.S.P.Q. 801 (B.P.A.I. 1977). Adopting the Petitioner's position would, however, permit the Government to discriminate against inventors whose inventions the Government deems to be as injurious to public morals. Thus, a politically conservative Director might deny a patent to contraceptives, a pacifist Director might deny a patent to weapons, a teetotaling Director to new method of making beer, and so on. While the Government has a right to ban the possession or manufacture of some inventions, *see, e.g.*, *Sentell v. New Orleans & Carrolton R.R. Co.*, 166 U.S. 698, 704 (1897) (noting that the Government can "in a bona fide exercise of its police power, may interfere with private property, and even order its destruction"), it cannot ban the scientific inquiry into questions that it disfavors, *see generally* Barry P. McDonald, *Government Regulation or Other "Abridgements" of Scientific Research: The Proper Scope of Judicial Review Under the First Amendment*, 54 Emory L.J. 979 (2005).

If the Court were to accept the argument that the consequence of trademark registration shows the Government's endorsement of the mark, *see* Pet.

Br. 39,[8] or the argument that the denial of trademark registration does not suppress speech because it does not preclude anyone from speaking, *see* Tuhsnet Br. 30, it would follow that the Government could also deny patents to inventors of products that the Government disapproves of. After all, the inventors would not be prohibited from speaking in other manner (for example, through scientific publications and the like). However, "[t]he primary purpose of our patent system is . . . disclosure of advances in knowledge which will be beneficial to society . . . ." *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 330–31 (1945). Limiting patent availability necessarily means less disclosure, and necessarily impedes the public's "right to receive information and ideas." *Stanley*, 394 U.S. at 564.

The resolution of how exactly the First Amendment applies to and constrains the Patent Act should be left for another day. Nonetheless, the Court's decision here will resonate throughout all of the intellectual property regimes. The Court should err on the side of equal access to intellectual property protection for all comers and let the free market sort

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[8] All of the arguments the Government advances in support of its position in the trademark arena would be applicable to patents as well. Issuance of a patent "would cause the [patent] to be published [i]n the [Official Gazette]; would cause a certificate for the [patent] to be issued 'in the name of the United States' . . . ; and would entitle [patentee to mark his product with a patent number] to convey to the public that the [patent] has an official status." *See* Pet. Br. 39.

out, as it always has, the offensive from the respectable, and the moral from the dissolute.

IV. Upholding § 2(a) Threatens Settled Property Rights

It is beyond dispute that trademarks are property of the trademark holder. *See, e.g., Clinton E. Worden & Co. v. Cal. Fig Syrup Co.*, 187 U.S. 516, 530 (1903) (holding that there exists a "right of property in a trade–mark, name, or symbol in connection with a particular manufacture or vendible commodity"); *Hutchinson, Pierce & Co. v. Loewy*, 217 U.S. 457, 459 (1910) ("The rule is well established that a trademark, word, or symbol has the elements of a property right."). Although the federal registration itself is not a property right, *In re Int'l Flavors & Fragrances, Inc.*, 183 F.3d 1361, 1366 (Fed. Cir. 1999) ("The federal registration of a trademark does not create an exclusive property right in the mark. The owner of the mark already has the property right established by prior use."), the denial of federal registration pursuant to § 2(a) may lead to the abrogation of all property rights in a trademark, irrespective of how long it may have existed, *see* Part I.B, *ante*.

The danger in § 2(a) depriving individuals of their long held property rights can be seen in the ongoing litigation over the Washington Redskins' trademark. The Redskins have used their name since 1933, *see Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 448 (E.D. Va. 2015), *appeal filed*, No. 15–1874 (4th Cir. filed Aug. 4, 2015) and therefore have acquired the property right to those marks at that time, *see Volkswagenwerk*

Aktiengesellschaft v. Wheeler, 814 F.2d 812, 815 (1st Cir. 1987) ("The right to trademark and service mark rights is based on prior use, or the one who first uses the marks in connection with a peculiar line of business."). Allowing the PTO to cancel these marks (or refuse registration on the grounds that they are "disparaging" or "scandalous") may preclude the owner from enforcing the mark either in state or federal court. *See* Part I.B, *ante*. In other words, the owner of the mark may be unable to prevail in an infringement action against any imitator or purveyor of counterfeit goods, because neither state nor federal courts will recognize his right to enforce the mark and exclude others from using the same. Necessarily, this would mean that the owner of the Redskins mark would lose all his property interest in that mark, because "[t]he hallmark of a protected property interest is the right to exclude others. That is 'one of the most essential sticks in the bundle of rights that are commonly characterized as property.'" *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 673 (1999) (quoting *Kaiser Aetna v. United States*, 444 U.S. 164, 176 (1979)). It is the right to exclude others that makes trademarks property. *Id.* And consequently, the loss of the right to exclude others deprives the owners of their property.

Should this Court reverse the judgment below, countless settled and valuable property rights, from professional sport teams like the Chicago Blackhawks, the Cleveland Indians, and the Atlanta Braves, to food products like Aunt Jemima, Uncle Ben's, and Uncle Tom's, to cast iron elements such as FAG, may end up being destroyed at the whim of the

government. These property rights, often worth millions of dollars will be completely destroyed simply because the Government disapproves of the message the right–holders are sending. With the same logic being applicable to copyright and patent rights, *see* Part III, *ante*, unpopular speakers will perpetually be at the mercy of the Government if it is permitted to dispense and withdraw its benefits based on its evaluation of how offensive the speech is.

It may well be that the time has come for some of these property owners to abandon their property and rebrand their products. But that is a decision to be made by the property owners and their customers, rather than by the Government.

CONCLUSION

For these reasons, the Court should affirm the judgment below and hold that the non–disparagement clause of § 2(a) of the Lanham Act is unconstitutional.

Respectfully submitted,

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